

ESTTA Tracking number: **ESTTA668133**

Filing date: **04/22/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|--|
| Name | NIOMEDIA LIMITED |
| Granted to Date of previous extension | 04/22/2015 |
| Address | 14 New Street London, EC2M4HE UNITED KINGDOM |

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| Attorney information | John J. Arnott HOWISON & ARNOTT, L.L.P. P.O. BOX 741715 Dallas, TX 75374-1715 UNITED STATES trade- marks@dalpat.com,phu@dalpat.com,jarnott@dalpat.com,apyczko@dalpat.com Phone:9724790462 |
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Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 86370126 | Publication date | 12/23/2014 |
| Opposition Filing Date | 04/22/2015 | Opposition Period Ends | 04/22/2015 |
| Applicant | Cho, Grace 8 Stone Drive Westport, CT 06880 UNITED STATES | | |

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Providing an internet website featuring news and information in the field of national and international politics; Providing information and news in the field of business; Providing information and news in the field of business, namely, information and news on current events and on economic, legislative, and regulatory developments as it relates to and can impact businesses; Providing information, news and commentary in the field of business

Class 041. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: On-line journals, namely, blogs featuring Art and history; Providing an Internet website portal featuring entertainment news and information specifically in the field of Art and History; Providing an on-line computer database in the field of history, namely, providing a searchable history database, focusing on the 15th century forward, including world history, military history, women's history, history of education, and featuring a bibliographic index of world history serial works, full text academic historical journals, periodical articles, reference books, primary source documents, monographs, biographies, images, and related to all aspects of history; Providing an online monthly column in the field of Art and History; Providing an online weekly column in the field of Art and History; Providing news in the nature of current event reporting; Provid-


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| ing news in the nature of current event reporting relating to Art and History via the Internet |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Other | Opposer's common law rights in pending applications could be damaged by registration of the subject mark. |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|--|-----------------------|------------|
| U.S. Application No. | 86320526 | Application Date | 06/25/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | NIO | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 009. First use: First Use: 0 First Use In Commerce: 0 Downloadable software for processing data in real time and near real time; downloadable software for providing a runtime environment for configurable services Class 042. First use: First Use: 0 First Use In Commerce: 0 Non-downloadable software for processing data in real time and near real time; non-downloadable software for providing a runtime environment for configurable services | | |

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|----------------------|--|-----------------------|------------|
| U.S. Application No. | 86320507 | Application Date | 06/25/2014 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | N.IO | | |
| Design Mark |  | | |

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|---------------------|---|
| Description of Mark | NONE |
| Goods/Services | <p>Class 009. First use: First Use: 0 First Use In Commerce: 0</p> <p>Downloadable software for processing data in real time and near real time; downloadable software for providing a runtime environment for configurable services</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Non-downloadable software for processing data in real time and near real time; non-downloadable software for providing a runtime environment for configurable services</p> |

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|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 86514846 | Application Date | 01/26/2015 |
| Registration Date | NONE | Foreign Priority Date | NONE |

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|-----------|-----------|
| Word Mark | N.IOMEDIA |
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|-------------|--|
| Design Mark |  |
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| Description of Mark | NONE |
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| Goods/Services | <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Computer software, namely, downloadables software for use on personal computers, smartphones, tablets, mobile devices, smart televisions and other networked computer devices for creating or facilitating an on-line presence where users can share information, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking featuring social media, photos, images, and topics of general interest to such users; computer software, namely, downloadable software for aggregating and integrating information, images and content from social networks, publicly available sources and personal websites and communications on a real-time or near real-time basis to provide and enable users to interact with information, images and content of greatest interest to them; computer software, namely, downloadable software that enables users of computers and mobile devices to access, aggregate, organize and interact with content, information and images from social media websites, publicly available sources, and personal websites and communications, and provides data, information and updates on a real-time or near real-time basis on topics of general interest to members of an on-line community; Entertainment and educational services, namely, website featuring articles, images, and photos about news, entertainment, and current events; providing a virtual environment where users can find and exchange articles, images, and photos about topics, people, and current events, and where users can interact for entertainment purposes and to express opinions about topics, people, and current events; computer services, namely, providing data, information and updates about entertainment on a real-time or near real-time basis on topics of interest to users of an on-line community; computer services, namely, providing data, information and updates about education on a real-time or near real-time basis on topics of interest to users of an on-line community; providing websites for the</p> |
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| | <p>general public featuring entertainment news and information in desired fields that is collected and presented in real-time or near real-time; providing websites for the general public featuring educational news and information in desired fields that is collected and presented in real-time or near real-time; Computer services, namely, providing an on-line site featuring non-downloadable software for users to share information, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking featuring social media, photos, images, and topics of general interest to such users; providing an interactive website featuring technology that aggregates and integrates information, images and content from social networks, publicly available sources and personal websites and communications on a real-time or near real-time basis and enables users to interact with information and content of greatest interest to them; computer services, namely, providing a web-based system and online portal featuring on-line non-downloadable software that enables users of computers and mobile devices to access, aggregate and interact on a real-time or near real-time basis with content, information and images from social media websites, publicly available sources, and personal websites and communications; providing a website featuring a media aggregator and search engine for internet and social content; application service provider, namely, providing, hosting, managing, developing, and maintaining applications, software, web sites, and databases of others in the fields of personal media and communications content; application service provider featuring software for use in the collection, dissemination, and assimilation on a real-time or near real-time basis of data, information, photos and images for social networking purposes; Online social networking services; providing a social networking website for entertainment and social communications purposes; computer services, namely, providing data, information and updates about social networking on a real-time or near real-time basis on topics of interest to users of an on-line community</p> |
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| Attachments | <p>86320526#TMSN.png(bytes) 86320507#TMSN.png(bytes) 86514846#TMSN.png(bytes) NMD32483 Notice of Opposition.pdf(354480 bytes)</p> |
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|----------------|
| Signature | /jja/ |
| Name | John J. Arnott |
| Date | 04/22/2015 |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | | |
|------------------|---|--------------------------------------|
| NIOMEDIA LIMITED | § | Opposition No. _____ |
| | § | |
| <i>Opposer</i> | § | In re the matter of: |
| | § | |
| v. | § | Application Serial No. 86/370,126 |
| | § | Mark: NIO |
| CHO, GRACE | § | |
| | § | Filed on August 18, 2014 |
| <i>Applicant</i> | § | |
| | § | Published in the Official Gazette on |
| | | December 23, 2014 |

TO THE TRADEMARK TRIAL AND APPEAL BOARD

NOTICE OF OPPOSITION

Opposer NIOMEDIA LIMITED (hereinafter "NIOMEDIA"), a private limited company organized and existing under the laws of the United Kingdom with an address of 14 New Street, London, United Kingdom EC2M4HE believes that it will be damaged by the issuance of a registration for the mark NIO (hereinafter "NIO Mark") in Application Serial No. 86/370,126 (hereinafter "the '126 Application") filed August 18, 2014, by GRACE CHO, a United States individual, with an address of 8 Stone Drive, Westport, Connecticut 06880 (hereinafter "Applicant"). NIOMEDIA hereby opposes Applicant's application pursuant to Section 13 of the United States Trademark Act, as amended, 15 U.S.C. §1063:

As grounds for opposition, NIOMEDIA alleges that:

NIOMEDIA MARKS

1. NIOMEDIA owns the marks and the associated U.S. trademark applications (collectively, hereinafter the NIOMEDIA Marks and NIOMEDIA Applications) for the following:

- a. NIO (U.S. Application Serial No. 86/320,526) filed on June 25, 2014, received Notice of Allowance on January 13, 2015, covering: Downloadable software for processing data in real time and near real time; downloadable software for providing a runtime environment for configurable services in Class 009 and Non-downloadable software for processing data in real time and near real time; non-downloadable software for providing a runtime environment for configurable services in Class 042;
- b. N.IO (U.S. Application Serial No. 86/320,507) filed on June 25, 2014, received Notice of Allowance on January 13, 2015, covering: Downloadable software for processing data in real time and near real time; downloadable software for providing a runtime environment for configurable services in Class 009 and Non-downloadable software for processing data in real time and near real time; non-downloadable software for providing a runtime environment for configurable services in Class 042; and
- c. N.IOMEDIA (U.S. Application Serial No. 86/514,846) filed on January 26, 2015, covering: Computer software, namely, downloadable software for use on personal computers, smartphones, tablets, mobile devices, smart televisions and other networked computer devices for creating or facilitating an on-line presence where users can share information, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking featuring social media, photos, images, and topics of general interest to such users; computer software, namely, downloadable software for aggregating and integrating information, images and content from social networks, publicly available sources and personal websites and communications on a real-time or near real-time basis to provide and enable users to interact with information, images and content of greatest interest to them; computer software, namely, downloadable software that enables users of computers and mobile devices to access, aggregate, organize and interact with content, information and images from social media websites, publicly available sources, and personal websites and communications, and provides data, information and updates on a real-time or near real-time basis on

topics of general interest to members of an on-line community; Entertainment and educational services, namely, website featuring articles, images, and photos about news, entertainment, and current events; providing a virtual environment where users can find and exchange articles, images, and photos about topics, people, and current events, and where users can interact for entertainment purposes and to express opinions about topics, people, and current events. computer services, namely, providing data, information and updates about entertainment on a real-time or near real-time basis on topics of interest to users of an on-line community; computer services, namely, providing data, information and updates about education on a real-time or near real-time basis on topics of interest to users of an on-line community; providing websites for the general public featuring entertainment news and information in desired fields that is collected and presented in real-time or near real-time; providing websites for the general public featuring educational news and information in desired fields that is collected and presented in real-time or near real-time; Computer services, namely, providing an on-line site featuring non-downloadable software for users to share information, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking featuring social media, photos, images, and topics of general interest to such users; providing an interactive website featuring technology that aggregates and integrates information, images and content from social networks, publicly available sources and personal websites and communications on a real-time or near real-time basis and enables users to interact with information and content of greatest interest to them; computer services, namely, providing a web-based system and online portal featuring on-line non-downloadable software that enables users of computers and mobile devices to access, aggregate and interact on a real-time or near real-time basis with content, information and images from social media websites, publicly available sources, and personal websites and communications. providing a website featuring a media aggregator and search engine for internet and social content; application service provider, namely, providing, hosting, managing,

developing, and maintaining applications, software, web sites, and databases of others in the fields of personal media and communications content; application service provider featuring software for use in the collection, dissemination, and assimilation on a real-time or near real-time basis of data, information, photos and images for social networking purposes; Online social networking services; providing a social networking website for entertainment and social communications purposes; computer services, namely, providing data, information and updates about social networking on a real-time or near real-time basis on topics of interest to users of an on-line community.

APPLICANT'S PENDING '126 APPLICATION

2. Applicant filed the '126 Application for NIO as an intent-to-use based application under Section 1(b) with the United States Patent and Trademark Office on August 18, 2014.
3. Applicant's '126 Application for NIO covers the services "Providing an internet website featuring news and information in the field of national and international politics; Providing information and news in the field of business; Providing information and news in the field of business, namely, information and news on current events and on economic, legislative, and regulatory developments as it relates to and can impact businesses; Providing information, news and commentary in the field of business in International Class 035" and "On-line journals, namely, blogs featuring Art and history; Providing an Internet website portal featuring entertainment news and information specifically in the field of Art and History; Providing an on-line computer database in the field of history, namely, providing a searchable history database, focusing on the 15th century forward, including world history, military history, women's history, history of education, and featuring a bibliographic index of world history serial works, full text academic historical journals, periodical articles, reference books, primary source documents, monographs, biographies, images, and related to all aspects of history; Providing an online monthly column in the field of Art and History; Providing an online weekly column in the field of Art and History; Providing news in the nature of current

event reporting; Providing news in the nature of current event reporting relating to Art and History via the Internet in International Class 041.”

4. Applicant’s 126 Application for NIO was published in the Official Gazette of the PTO on December 23, 2014. NIOMEDIA subsequently filed requests for extension of time to oppose which were granted, extending the time to oppose to April 22, 2015.
5. Upon information and belief, no Allegation of Use has been filed by Applicant for the ‘126 Application for NIO.
6. NIOMEDIA is not affiliated or connected with Applicant or its services covered under the ‘126 Application; nor has NIOMEDIA endorsed or sponsored Applicant’s services covered under the ‘126 Application.

**FIRST GROUND FOR OPPOSITION
LIKELIHOOD OF CONFUSION**

7. NIOMEDIA re-alleges the allegations contained in Paragraphs 1-6 of this Notice of Opposition.
8. NIOMEDIA’s ‘526 Application for NIO and ‘507 Application for N.IO were both filed under Section 1(b) on June 25, 2014. Applicant’s ‘126 Application for NIO was filed under Section 1(b) on August 18, 2014. No date of first use was claimed by Applicant at filing, and to date no Allegation of Use has been filed. Accordingly, NIOMEDIA enjoys priority as a result of the earlier filing dates of its applications for the NIO and N.IO trademarks.
9. NIOMEDIA’s ‘526 Application for NIO and ‘507 Application for N.IO each received a Notice of Allowance on January 13, 2015. Accordingly, NIOMEDIA’s applications for NIO and N.IO are proceeding towards registration.
10. All of the NIOMEDIA Marks contain the term “NIO”.
11. The mark that Applicant in the ‘126 Application seeks to register, “NIO”, is highly similar/identical to the NIOMEDIA Marks in appearance, sound, meaning, and commercial impression because it incorporates the dominant components of the NIOMEDIA Marks, namely “NIO.”

12. The NIOMEDIA Marks and the NIO Mark are highly similar in appearance. The mark in the NIOMEDIA '526 Application, NIO, is identical to Applicant's NIO mark. The mark in the NIOMEDIA '507 Application, N.IO, is substantially identical to Applicant's NIO mark, differing only in the presence of a period. The mark in NIOMEDIA's '846 Application, N.IOMEDIA, starts with the same substantially identical N.IO, and then adds the further term "MEDIA". The first portion of a mark is generally seen as the key portion. Generally, if the dominant and/or key portion of two marks is the same, then confusion may be likely notwithstanding the peripheral differences. In this case, the addition of the term "MEDIA" and along with the punctuation between the "N" and "I" are not sufficient to distinguish the appearance of the NIOMEDIA's Marks from the NIO Mark. Therefore, the NIO Mark is confusingly similar in appearance to all three of the NIOMEDIA Marks.
13. The NIOMEDIA Marks and the NIO Mark are highly similar in sound or pronunciation. NIOMEDIA's NIO and N.IO marks are pronounced "Nee-Yo." The NIO Mark is pronounced "Nee-Yo" The pronunciations are identical. NIOMEDIA's N.IOMEDIA mark is pronounced "Nee-Yo-Me-Dee-Ya"). When pronouncing the word NIO, emphasis is given to the "Nee-Yo" portion of the word. When heard, the distinct and memorable portion of the word is "Nee-Yo." Because the sound or pronunciation of the NIOMEDIA Marks and the NIO Mark are identical, consumer confusion is likely.
14. The services covered by the NIOMEDIA Applications and the services covered by the Applicant's '126 Application are similar. Generally, the respective goods/services need only be related in some manner or the conditions surrounding their marketing be such that they will be encountered by the same consumers under circumstances that would lead to the mistaken belief that the goods/services originate from the same source. In this case, the services covered under the various NIOMEDIA Marks include, but are not limited to non-downloadable software for processing data in real time or near real time and Computer services, namely, providing an on-line site featuring non-downloadable software for users to share information, participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking. Similarly, Applicant's '126 Application covers internet website services in the field of national and international

politics, providing information and news in the field of business and on-line journals, namely, blogs featuring art and history and providing an internet portal featuring entertainment news and information specifically in the field of art and history. Because the NIOMEDIA Marks and the NIO Mark cover similar services relating to providing information for third parties on-line, consumers encountering the NIO Mark and the NIOMEDIA Marks for these related services are likely to mistake the underlying sources of the related services provided under the NIOMEDIA Marks and the NIO Mark.

15. The services covered by Applicant's '126 Application are also related to the goods covered by the NIOMEDIA Applications. NIOMEDIA's and Applicant's goods/services are similar because they both include either providing information or data services or providing downloadable goods that process information or data. Applicant provides online information related to various topics (politics, history, art, etc.), while NIOMEDIA provides downloadable software for processing information and data. Although, Applicant does not provide goods related to information or data processing, the services covered by the NIOMEDIA Marks and the services provided under the NIO Mark are in a similar industry (e.g., information/data processing). Therefore, the relevant consumers of NIOMEDIA's and Applicant's goods/services are likely to encounter these goods/services and the NIOMEDIA Marks and the NIO Mark in the information/data processing industry. Given the strong similarities, between the NIOMEDIA Marks and the NIO Mark, consumers are likely to confuse the marks and mistake the underlying sources of the parties' respective goods/services.

16. The overall commercial impression between the NIOMEDIA Marks and Applicant's NIO Mark are similar. The test for likelihood of confusion focuses on the average purchaser, who normally retains a general rather than specific impression of trademarks. In this case, the NIO Mark creates a very similar overall commercial source impression to the NIOMEDIA Marks. The terms "NIO" and "NIO" are identical in appearance and sound, and the terms "NIO" and "N.IO" are practically identical in appearance and sound. The dominant and distinctive portion of NIO is obviously "NIO", because Applicant's NIO has no other elements by which to distinguish it from NIOMEDIA's NIO, N.IO and N.IOMEDIA. While some of the NIOMEDIA Marks contain an additional punctuation

(e.g., N.IO) or additional wording (e.g., N.IOMEDIA) these additional punctuations and letters do not change the dominant NIO, which creates the source impression in both the NIOMEDIA Marks and the NIO Mark. Because commercial impression between the NIOMEDIA Marks and the NIO Mark are similar, likelihood of consumer confusion is high.

17. The channels of trade are similar between the NIOMEDIA Marks and Applicant's NIO Mark. Because the goods covered under the NIOMEDIA Applications and Applicant's '126 Application are identical or closely related, they are presumed to travel in the same channels of trade. Absent restrictions in an application and/or registration, the similar goods are presumed to travel in the same channels of trade to the same class of purchasers. In this case, neither party has restrictions concerning channels of trade on their applications or registrations. Therefore, consumers are very likely to encounter the NIOMEDIA Marks and the NIO Mark in the same commercial contexts and market channels (e.g., on the internet). Thus, consumer confusion will result as to the source of the goods/services provided under the NIOMEDIA Marks and Applicant's NIO Mark.
18. Because Applicant's NIO Mark is substantially similar to the NIOMEDIA Marks in at least appearance, sound and overall commercial impression, because the respective goods/services are closely related, and because the goods/services travel in the same channels of trade, registration of Applicant's NIO Mark will cause the public to be confused or mistaken into believing that the goods and services provided by Applicant are produced, endorsed or sponsored by NIOMEDIA.
19. Accordingly, registration of Applicant's NIO Mark will damage NIOMEDIA because Applicant's NIO Mark is likely to cause confusion among the purchasing public. Thus, Applicant's NIO Mark is unregistrable under Sections 2(d) of the United States Trademark Act, as amended, 15 U.S.C. §§1052, and should be refused registration.

**SECOND GROUND FOR OPPOSITION
OTHER INTERESTS**

20. NIOMEDIA's '846 Application for N.IOMEDIA was filed under Section 1(b) on January 26, 2015, following allowance of the '526 and '507 applications for NIO and N.IO, respectively. NIOMEDIA believes that the mark N.IOMEDIA is closely related to its marks NIO and N.IO, and therefore, falls squarely within a predictable zone of expansion for NIOMEDIA's marks. If Applicant's NIO mark in the '126 Application is allowed to register, NIOMEDIA's interests in the '846 Application could be harmed by possible refusal to register the N.IOMEDIA mark in view of Applicant's NIO mark.

CONCLUSION

21. Wherefore, NIOMEDIA prays that this Opposition be sustained, and that Application Serial No. 86/370,126 be refused.

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Please recognize the following as attorneys for NIOMEDIA in this proceeding: John J. Arnott, Gregory M. Howison, Ed Jorgenson, Brian D. Walker, Steven Greenfield, Andrew Graham, Patricia Q. Hu and Keith Harden (members of the Texas Bar) and the firm of Howison & Arnott, LLP, P.O. BOX 741715, Dallas, Texas 75374-1715.

Please address all communications to John J. Arnott at the address below.

In accordance with 37 C.F.R. §§2.101 and 2.6(a)(17), the fees for two International Class for the opposed application are submitted herewith.

Respectfully submitted,

Howison & Arnott, LLP

John J. Arnott

Date: April 22, 2015

By: 

John J. Arnott

Attorneys for Opposer

P.O. BOX 741715

Dallas, Texas 75374-1715

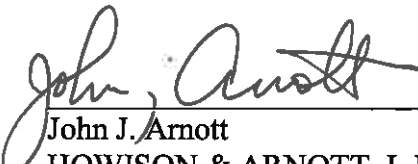
(972) 467-0462

CERTIFICATE OF SERVICE

I hereby certify that on April 22, 2015, true and complete copies of the foregoing Notice of Opposition has been served by mailing said copies on April 22, 2015, via U.S. First Class mail, postage prepaid to Applicant Grace Cho and her attorney at the following addresses:

Grace Cho
8 Stone Drive
Westport, Connecticut 06880
United States

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ATTORNEY FOR OPPOSER

NIOMEDIA LIMITED